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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,854	09/27/2000	Ikuyo Ikeda	196466US 2	6529

22850 7590 09/10/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

TRAN, QUOC A

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,854

Applicant(s)

IKEDA, IKUYO

Examiner

Quoc A. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 07/12/2004 and amendment, filed 05/11/2004, to the original application filed 09/27/2000.
2. Claims 15-24 are currently pending in this application. Claims 15, 18, 21, and 24 are independent claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/22/2004 has been entered.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application

filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-20, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee. US Patent No. 6,208,427 B1 issued 03/27/2001 filed 11/18/1997 (hereinafter '427).

In regard to independent claim 24, *"displaying an original document on a screen as a preview of printing; receiving, at least one of a text, an image, and a graphic to be inserted into an image of the displayed original document from a user; receiving a position specified by the user on the displayed image on the screen so as to form a space for inserting the at least one of the text, image, and graphic; inserting the at least one of the text, image, and graphic into the formed space; and displaying a combined image on the screen"*, as taught by '427 at col. 2, lines 25-55 (i.e. printing method has also been developed for a PDA which has a display capable of displaying characters and graphic data, a fax modem capable of transmitting and receiving fax data, and a memory capable of storing data...user interface through the display that allows a user to select a fax note stored in the memory, insert/remove a fax header, and set upper, lower, right, and left margins...selecting one of an insertion and removal menu...setting upper, lower, right, and left margins...converting the note and the margin instructions into bit map image data...).

In regard to independent claim 18, is directed to a recording medium for performing the method of claim 24, and is similarly rejected under the same rationale.

In regard to dependent claim 19, "printer driver program", as taught by '427 col. 1, lines 30-40 (i.e.... a driver program for driving the printer...).

In regard to dependent claim 20, "a printer", as taught by '427 at col. 1, lines 7-10 (i.e.... personal digital assistant (PDA), and more particularly, to a PDA printer and a printing method containing a display capable of displaying characters and graphic data...).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 15-17, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable by Lee US Patent No. 6,208,427 B1 issued 03/27/2001 filed 11/18/1997 (hereinafter '427), in view of Hansen et al US patent No. 6,462,756 B1 issued 10/08/2002 filed 05/17/2000 (hereinafter '756).**

In regard to independent claim 15, is directed to an apparatus for performing the method of claim 24, and in further view of the following, and are similarly rejected under the same rationale;

'427 does not explicitly teach, "*A controlling device for a printing image*", however as taught by '756 at col.2, lines 30-40 (i.e.... representing and controlling a production printing workflow... The interface ... a display... the display and capable of being associated with the first document object; a first user input device for selectively associating at least two of the first, second and third visual representations...);

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified '756 into '427 to provide a controlling device for a printing image. One of the ordinary skills in the art would have been motivated to perform such a modification to provide a print image forming device that capable of producing high quality document and the ability to manipulate the original document plus the instruction for producing the finishing product in either hard copy or electronic form, such as on floppy disk, compact disc or tape or can be transmitted to a printer over a network such as the Internet, as taught by '756 at col. 1, lines 15-45 (i.e.... capable of producing high quality...).

In regard to dependent claim 16, "*the inserting device reduces the image to be printed and moves the reduced image in up-and-down and right-and-left directions on the screen so as to form a space for inserting the at least one of the text, image, and graphic*", as taught by '427 at col. 2, lines 25-30 (i.e. The printing... providing a user interface through the display that allows a user to select a fax note stored in the memory, insert/remove a fax header, and set upper, lower, right, and left margins... selecting one of an insertion... setting upper, lower, right, and left margins ...).

'427 does not explicitly teach, "*A controlling device for a printing image*", however as taught by '756 at col.2, lines 30-40 (i.e.... representing and controlling a production printing workflow... The interface ... a display... the display and capable of being associated with the first document object; a first user input device for selectively associating at least two of the first, second and third visual representations...);

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified '756 into '427 to provide a controlling device for a printing image. One of the ordinary skills in the art would have been motivated to perform such a modification to provide a print image forming device that capable of producing high quality document and the ability to manipulate the original document plus the instruction for producing the finishing product in either hard copy or electronic form, such as on floppy disk, compact disc or tape or can be transmitted to a printer over a network such as the Internet, as taught by '756 at col. 1, lines 15-45 (i.e.... capable of producing high quality...).

In regard to dependent claim 17, is directed to an apparatus for performing the method of claim 24, and in further view of the following, and are similarly rejected under the same rationale;

'427 does not explicitly teach "*the combined image is edited by a drag and drop operation on the preview of printing*", however as taught by '756 at col. 9, lines 24-40 (i.e. ... the GUI interface, documents... (collectively "objects") are visually represented on the workstation 116 display, such as with icons, tree structures and pull-down menus, and may be interacted with using known devices and methods such as utilizing

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a mouse or track ball to control a visually represented pointing device which is then used to click, select, drag and drop the displayed representations... the GUI also permits creation and manipulation of relationships and associations among the various objects and visually displays such relationships and associations ...).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified '756 into '427 to provide a user interface for combining image by a drag and drop operation on the preview of printing. One of the ordinary skills in the art would have been motivated to perform such a modification to provide a print image forming device that capable of producing high quality document and the ability to manipulate the original document plus the instruction for producing the finishing product in either hard copy or electronic form, such as on floppy disk, compact disc or tape or can be transmitted to a printer over a network such as the Internet, as taught by '756 at col. 1, lines 15-45 (i.e.... capable of producing high quality...).

In regard to independent claim 21, is directed to an apparatus for performing the method of claims 24, and in further view of the following, and are similarly rejected under the same rationale;

"a printer driver configured to be booted based on a received command from an application program, the printer driver comprising", as taught by '427 col. 1, lines 30-40 (i.e.... a driver program for driving the printer...);

'427 does not explicitly teach, *"A controlling device for a printing image"*, however as taught by '756 at col.2, lines 30-40 (i.e.... representing and controlling a production printing workflow... The interface ... a display... the display and capable of being

associated with the first document object; a first user input device for selectively associating at least two of the first, second and third visual representations...);

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified '756 into '427 to provide a controlling device for a printing image. One of the ordinary skills in the art would have been motivated to perform such a modification to provide a print image forming device that capable of producing high quality document and the ability to manipulate the original document plus the instruction for producing the finishing product in either hard copy or electronic form, such as on floppy disk, compact disc or tape or can be transmitted to a printer over a network such as the Internet, as taught by '756 at col. 1, lines 15-45 (i.e.... capable of producing high quality...).

In regard to dependent claim 22, incorporate substantially similar subject matter as cited in claim 16 above, and is similarly rejected along the same rationale.

In regard to dependent claim 23, incorporate substantially similar subject matter as cited in claim 17 above, and is similarly rejected along the same rationale.

Response to Argument

7. Applicant's arguments filed 07/22/2004 have been fully considered but are moot in view of the new ground(s) of rejection.

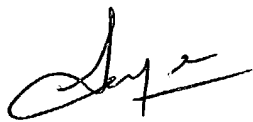
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781, **"After mid-Oct, 2004, the examiner can be reach at (571) 272- 4103"**. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran
Patent Examiner
Technology Center 2176
September 3, 2004


SANJIV SHAH
PRIMARY EXAMINER